

PATENT

ATTORNEY DOCKET NO: SMD-58-CON

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Peterson, et al.)	
)	Examiner: Lazorcik, Jason L
Serial No: 10/813,107)	
)	Art Unit: 1791
Filed: March 30, 2004)	
)	Deposit Acct. No: 04-1403
Title: Process for Producing Smoking Articles)	
With Reduced Ignition Proclivity)	Confirmation No: 5544
Characteristics and Products Made)	
According to Same)	Customer ID No.: 22827

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. 1.132

I, Richard M. Peterson, do hereby declare as follows:

My home address is 709 Springer Mountain Dr., Canton, Georgia.

I have a Bachelor of Science in Chemical Engineering and MS and PhD degrees in Paper Science and Technology. I am currently retired. Prior to retirement, I was employed in the papermaking industry for over 31 years. Over the course of my career, I worked for the Kimberly-Clark Corporation and for Schweitzer-Mauduit International, Inc.

I am a co-inventor of the claimed invention described and defined in the above-identified United States Patent Application.

Currently, claims 41 through 65, 68 through 108 and 110 through 120 remain pending in the present application including independent claims 41, 70, 83 and 113. The claims are directed to a paper wrapper for a smoking article or to a smoking article.

Claim 41, for instance, is as follows:

A paper wrapper for a smoking article comprising:

a paper web having a permeability of greater than about 60

Coresta; and

treated discrete areas on the paper web formed by applying a film-forming composition to the paper web, the treated discrete areas being separated by untreated areas, the treated discrete areas having a permeability of less than about 25 Coresta and a BMI of less than about 5 cm⁻¹, the treated areas reducing ignition proclivity of a smoking article incorporating the paper wrapper sufficient for the smoking article to pass a test entitled Cigarette Extinction as established by NIST (National Institute of Standards and Technology).

In the latest Office Action, claims 41 to 65, 68 to 108, and 110 to 120 were rejected in view of various prior art references. The references include U.S. Patent No. 5,878,753 to Peterson, U.S. Patent No. 4,739,755 to Hampl et al., and U.S. Patent No. 6,298,860 to Hampl et al.

I am a listed co-inventor on U.S. Patent No. 5,878,753, which is the primary reference relied on by the Examiner.

In response, in my opinion, one skilled in the art at the time of the invention using common sense would not have utilized a wrapping paper having a permeability of greater than about 60 Coresta as required in the currently pending claims in the smoking articles disclosed in my prior patent. My prior patent, for instance, explicitly teaches minimizing permeability changes between the treated areas and the untreated areas in the wrapper. In column 9, for example, the patent states that "if the change in permeability between the treated areas and untreated areas of the cigarette is relatively great, the smoker will discern a difference in taste and smoke delivery."

In fact, one of the main objectives in my prior patent (U.S. Patent No. 5,878,753) was to minimize changes in permeability on wrappers for smoking articles that included treated bands. In column 2, for instance, the '753 patent states as follows:

A noticeable difference in taste and smoke delivery is discernable by the smoker depending on the difference in permeabilities between the untreated and treated sections of the paper. Thus, what is needed, is a paper which remains effective in reducing ignition propensity or proclivity while minimizing the chance of discernable changes in smoke delivery and taste to a smoker.

When one skilled in the art views my prior patent in its entirety, there is an unmistakable teaching to minimize permeability differences between the treated areas and the untreated areas. Thus, it is my opinion that one skilled in the art would not have looked to incorporating relatively high permeability wrappers, i.e. wrappers having a

permeability of greater than about 60 Coresta, into the wrapper constructions disclosed in my previous patent.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-captioned application or any patent issuing thereon.

Respectfully submitted,

Nov. 3, 2009
Date

Richard M. Peterson
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